

Response to Restriction Requirement and Amendment
Application No. 10/006,017
Amendment dated June 21, 2004
Reply to Office Action of May 19, 2004
Attorney Docket No. 717901.19

RESPONSE/REMARKS

Responsive to the Restriction Requirement, dated May 19, 2004, Applicant hereby provisionally elects for prosecution at this time Group I, Claims 1-9, and newly drafted Claim 11, drawn to a mat used as a playing surface. The election of Group I claims is made with traverse without prejudice to the elected Group I claims and without prejudice to the non-elected Group II, i.e., Claim 10.

The Applicant contends that Group I and Group II Claims are closely related and have a common utility. The Applicant further contends that the Group I and Group II Claims do not pose a serious burden for the Examiner by requiring two separate searches since Group I is the product claim and Group II is the method for making that particular product. Since Claim 10 is directed to making a "...mat for use as a playing surface....," it is respectfully believed that this Claim would not be construed to include a method for making a cake or a pastry.

Claim 1 is amended to recite: "A mat suitable for use as a playing surface, the mat comprising a support matrix of paper maché and a filler material, wherein the support matrix and the filler material are admixed uniformly in the mat. Support for this Amendment is found on Paragraph [0030] as follows: "Alternatively or desirably, paper maché may be mixed with binder or filler material and the paper maché, when set, provides further structural stability to the mat in addition to altering the mat playing characteristics." Therefore, no new matter is added. Claim 10 has been amended to comport with Claim 1.

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Moreover, the Applicant provisionally, and without prejudice, elects the Species for the filler material as a mixture of sand (0% to 100%) and soil (0% to 100%), which is fully supported in Paragraph [0081], Lines 4-6 as follows: "The soil content mixed with the paper maché can vary from inorganic sand and clay to organic composts and peat. The percentage proportions of each can vary from 100% to nil, according to the properties required of the mat for the type of club and golf shot to be practiced." This is reflected in newly added Claim 11. Therefore no new matter is added.

Moreover, Claim 7 is a markush claim that lists "at least one" of a variety of materials that can be used as the filler material. Therefore, this Claim should not be restricted to only one Species in a markush claim where combinations are possible. It is respectfully believed that this Claim, as currently drafted, should be evaluated in its totality and not broken apart and analyzed element-by-element for separate inventions. The Manual for Patent Examining Procedure recites in Section 803.02:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in In re Weber, 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 U.S.P.Q. 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 U.S.P.Q. 300 (CCPA 1980); and Ex parte Hozumi, 3 U.S.P.Q. 2d 1059 (Bd. Pat. App. &

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Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

In this case, the elements have the common utility of representing filler material for the mat, which is a shared structural feature essential to that utility.

Because Applicant may wish to pursue claims of the non-elected Group at a later date by Divisional Application, if necessary, it is requested that these Claims, pursuant to 37 CFR 1.142, be permitted to remain in the Application.

This Response does not present any new matter. Accordingly, as all requirements of the Restriction Requirement have been complied with, an action on the merits and a Notice of Allowance are hereby respectfully solicited.

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If any issue regarding the allowability of any of the pending claims in the present Application could be readily resolved, or if other action could be taken to further advance this Application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

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